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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/643,399	08/19/2003	Roy V. Ekberg	59881	3986
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HARSHAW RESEARCH INCORPORATED			RADA, ALEX P	
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OTTAWA, KS 66067			PAPER NUMBER	

3713

DATE MAILED: 11/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/643,399

Applicant(s)

EKBERG, ROY V.

Examiner

Alex P. Rada

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-11, 15 and 16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-11 and 15-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

In response to the amendment filed September 1, 2004 in which the applicant cancels claims 1-7 and 12-14, amends claim 8, adds new claims 15-16, and claims 8-11 and 15-16 are pending in this office action.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 8-11 and 15-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The disclosure as originally filed does not disclose the limitation of a plurality of magnets positioned beneath a top surface of the display board only in the book receiving section and the at least one card receiving section. The examiner request applicant to point out in the disclosure the claimed limitation of the plurality of magnets only in the book receiving section and the at least one card receiving section.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 8-9, 11, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Werzberger (US 5,951,298) in view of Burrows (US 6,217,405) and Herman (US 3,938,831).

5. Werzberger discloses the following:

A display board (510) having a book receiving section (figures 10A-10B) and at least one card receiving section, the book and card receiving sections being separated from one another, a book having a story text imprinted therein and a first set of distinctive markings imprinted therein at predetermined locations in the story text, in which the examiner interprets the key indicia 1 to be an equivalent to a book having a story text imprinted therein and a first set of distinctive markings imprinted therein at predetermined locations in the story text (figures 10A-10B), and a set of cards having a second set of distinctive markings imprinted on respective cards, the second set of distinctive markings corresponding to the first set of distinctive markings, the set of cards being ordered such that the second set of distinctive markings are encountered in the same order as the first set of distinctive markings are encountered in the story text, in which the examiner interprets the first and second directions books having key indicia 1 and 2 corresponding to the book (20) to be an equivalent to a set of cards having a second set of distinctive markings imprinted on respective cards, the second set of distinctive markings corresponding to the first set of distinctive

markings, the set of cards being ordered such that the second set of distinctive markings are encountered in the same order as the first set of distinctive markings are encountered in the story text (figures 10A-10B, abstract, and col.13, line 17- col. 14, line 11) as recited in claim 8.

A display board (510) having a book receiving section (figures 10A-10B) and at least one card receiving section, the book and card receiving sections being separated from one another, at least one divider partition for separating the book and card receiving sections, in which the examiner interprets the support members to be an equivalent to at least one divider partition for separating the book and the card receiving sections (figures 10A-10B), a book having a story text imprinted therein and a first set of distinctive markings imprinted therein at predetermined locations in the story text, in which the examiner interprets the key indicia 1 to be an equivalent to a book having a story text imprinted therein and a first set of distinctive markings imprinted therein at predetermined locations in the story text (figures 10A-10B), and a set of cards having a second set of distinctive markings imprinted on respective cards, the second set of distinctive markings corresponding to the first set of distinctive markings, the set of cards being ordered such that the second set of distinctive markings are encountered in the same order as the first set of distinctive markings are encountered in the story text, in which the examiner interprets the first and second directions books having key indicia 1 and 2 corresponding to the book (20) to be an equivalent to a set of cards having a second set of

distinctive markings imprinted on respective cards, the second set of distinctive markings corresponding to the first set of distinctive markings, the set of cards being ordered such that the second set of distinctive markings are encountered in the same order as the first set of distinctive markings are encountered in the story text (figures 10A-10B, abstract, and col.13, line 17-col. 14, line 11) as recited in claim 15.

Werzberger does not expressly disclose the following:

A plurality of magnets positioned at predetermined locations beneath a top surface of the display board *only in the book receiving section and the at least one card receiving section* and the book includes front and back covers having metallic elements positioned beneath respective first surfaces thereof, the metallic elements being configured to be magnetically drawn to corresponding magnets of the plurality of magnets of the display board when the front and back covers are positioned on the book receiving section as recited in claims 8 and 15.

A first surface, a metallic element positioned beneath the first surface such that the metallic element is magnetically drawn to the corresponding magnets on the display board as recited in claim 9.

The plurality of magnets having disk-shaped configuration as recited in claims 11.

Burrows teaches the following:

A plurality of magnets positioned at predetermined locations beneath a top surface of a display board *only in the book receiving section and the at least one*

card receiving section, in which the examiner interprets the specific magnetized areas to be an equivalent to the plurality of magnets positioned at predetermined locations (figure 1 and abstract) as recited in claim 8.

A first surface, a metallic element positioned beneath the first surface such that the metallic element is magnetically drawn to the corresponding magnets on the display board, in which the examiner interprets the removable playing pieces having the functional equivalent to the first surface and the metallic elements magnetically drawn to the corresponding magnets on the display board (column 5, line 52 – column 6, line 55) as recited in claim 9.

By having a plurality of magnets positioned at predetermined location on a display board and attachable elements having magnetic elements drawn to the corresponding magnets on the display board, one of ordinary skill in the art would provide an interactive substrate for books and other educational or instructional material for children.

Herman teaches the following:

The front and back covers including metallic element positioned on respective first surface configured to be secured to the display board as recited in claims 2 and 3. By having a metallic element positioned on or within a book cover, one of ordinary skill in the art would provide a cover that is not easily susceptible to damage.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Werzberger to include a

plurality of magnets positioned at predetermined locations beneath a top surface of the display board *only in the book receiving section and the at least one card receiving section*, a first surface, a metallic element positioned beneath the first surface such that the metallic element is magnetically drawn to the corresponding magnets on the display board, and the display board includes a receiving section in which the metallic element is magnetically drawn to the magnets on the display board as taught by Burrows to provide an interactive substrate for books and other educational or instructional material for children.

At the time the invention was made, it would have been an obvious design choice to a person of ordinary skill in the art to provide magnets in disk-shaped configuration because Applicant has not disclosed that having a plurality of magnets in a disk-shaped configuration as recited in claim 11 provides an advantage or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the equivalent fasteners as taught by Burrows because any type of fastener would provide the same function of holding objects to a base or support.

6. Claims 10 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Werzberger (US 5,951,298) in view of Burrows (US 6,217,405) as applied to claims 8 and 15 above, and further in view of Wood (5,511,980).
7. Werzberger in view of Burrows disclose the claimed invention as discussed above except for the following:

The set of cards having a barcode and the system further having a central processing unit, a means for communicating a selected barcode from a card and means for processing the barcode and generating an output signal corresponding to the selected barcode as recited in claims 10 and 16.

Wood teaches the following:

A set of cards (figure 1) having a barcode, in which the examiner interprets the pins holes (36) to be a functional equivalent to the barcode (column 4, lines 38-49) and the system further having a processing unit (figure 6), a means for communicating a selected barcode from a card and means for processing the barcode and generating an output signal corresponding to the selected barcode (summary) as recited in claims 6, 10, and 14. By having a barcode and a means for communicating the selected barcode from a card and generating an output signal corresponding to the selected barcode, one of ordinary skill in the art would provide children with an interactive device that facilitates the learning process for speaking, reading, and memorization.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Werzberger to further include a set of cards having a barcode and the system further having a central processing unit, a means for communicating a selected barcode from a card and means for processing the barcode and generating an output signal corresponding to the selected barcode as taught by Wood to provide children with an interactive device that facilitates the learning process for speaking, reading, and memorization.

Response to Arguments

8. Applicant's arguments filed September 1, 2004 have been fully considered but they are not persuasive.

Applicant contends that the cited prior art references do not disclose, teach, or suggest "a plurality of magnet positioned beneath a top surface of said display board in said book receiving section a said at least one card receiving section" (claim 8, lines 5-6). In other words, magnets are not positioned beneath the entire top surface of the display board in the currently claimed invention, but rather only beneath a book receiving section and at least one card receiving section.

In response the combined cited reference does disclose the claimed invention as discussed above. The added limitation of the plurality of magnets only in the book receiving section and the at least card receiving section is considered new matter as noted in the rejection above.

Applicant contends that disclose the set of cards in the currently claimed invention to be ordered such that the second set of distinctive markings are encountered in the same order as the first set of distinctive markings are encountered in the story text.

In response, Werzberger discloses as noted in the abstract that each page contains textual material, key indicia and an activity area. Each activity area contains instructions for conducting an activity. The activity is coordinated with the key indicia appearing on a simultaneously visible one of the plurality of pages. The key indicia can be any device capable of visually or tactilely distinguishing a portion of the text, allowing it to be associated with the activity. The key indicia are preferably selected from a group consisting of a word, a phrase, a sentence, a symbol, an object, a font, highlighting, an icon, and a color code in the textual material and are visually distinguishable from the surrounding textual material on the pages. The activity area typically, but not necessarily, contains pictorial material that is related to the activity, which is described in the activity area.

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Examples of activities include pictures, puzzles, mazes, and other graphical or textual instructions.

Each activity may have a code associated therewith for designating the age level appropriate for the particular activity and for designating the activity type.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alex P. Rada whose telephone number is 571-272-4452. The examiner can normally be reached on Monday - Friday, 08:00-16:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on 571-272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

APR



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SUPERVISORY EXAMINER